

Remarks

Now pending are claims 1 to 8, 10 to 17, and 20 to 40, of which claims 1, 17, and 33 are independent. Claim 9 is canceled and the subject matter of claim 9 is incorporated into claim 1. Because claim 9 was not rejected substantively in view of the art, the amendment to old claim 9 (clearing up the section 112(1) problem) means that claim 1 becomes immediately allowable. The applicants dispute the propriety of the section 112(1) rejection because the original filed claims are their own support. The written description portion of 112(1) does not require the disclosure as originally filed to provide *in haec verba* (identical wording) support for the now claimed subject matter. Fujikawa v. Wattanasin, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996). All that is required is that the disclosure convey to the ordinary artisan that the inventor had possession of the invention, In Re Parks, 30 USPQ2d 1234, 1236 (BPAI 1994), such that the artisan could discern the invention. Waldemar Link GmbH v. Osteonics, 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994). That the detailed description does not provide for identical wording does not negate that the original claims clearly refer to a temperature not lower than the melting point of the conductor. The applicants can amend the specification to recite in the specification that which is in claims. Without waiving any rights to claiming temperatures at the melting point or above, the applicant in the effort to expedite prosecution has amended the claim. Now that claim 1 is allowable, all dependent claims become allowable.

Claims 24 and 25 are also so amended but claim 25, which is clearly allowable because it too was not substantively rejected, is not added to claim 17. Rather, new independent claim 33 is the combination of claim 17 and claim 25. Claim 33 is allowable. Dependent claims therefrom are also allowable.

As for the section 112(2) issues, the claims are amended to correct what are obviously cosmetic errors and no scope of subject matter is intended to surrendered as none of the amendments are narrowing amendments. As for the negative limitations issue, the MPEP 2173.05(i) clearly states that negative limitations are allowed. The examiner has not cited to any MPEP section that says that negative limitations are not allowed. Because the examiner presumably based this on the combination with the improper 112(1) issue, it is abundantly clear that the negative limitation is clearly supported and clearly understandable to the person of ordinary skill in the art.

In particular, with respect to claim 24 and the section 112(2) rejection, the applicant notes that no such language exists in claim 24. The rejection is inappropriate.

With respect to the 102(b) rejection of claim 1 in view of Murthy, as explained above, this is moot considering the addition of old claim 9. All dependent claims are not anticipated.

As for claim 17, the rejection is overcome in view of the amendment to claim 17 that added the elements of old claims 18 and 19 to claim 17. Murthy fails to teach a silicon semiconductor as the entity to be etched using a dry etch process. While the examiner points to several portions of various figures, nothing teaches the process in those figures. In fact, the specification teaches that the Murthy etch is a wet etch using a buffered hydrofluoric acid, exactly opposite from what is claimed. Accordingly, claim 17 is not anticipated. If the examiner intends to argue that dry etching is well known in the art, then the applicant, in advance, requires the examiner to execute a Rule 1.104(d)(2) that clearly specifies the details of what facts are being supplied, or what references will be used with pin point citations. The applicant will need this affidavit to specifically identify all the details so that the record is complete for any appeal. See In re Lee, 277 F.3d 13338, 1344-45, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002) (finding that reliance on "common knowledge and common sense" did not fulfill the PTO's obligation to cite

references to support its conclusions as PTO must document its reasonings on the record to allow accountability and effective appellate review.)

As for the obviousness rejections, because claim 17 is not rejected for obviousness, every dependent claim cannot be obvious. Furthermore, Murthy is the base reference that is used in the combination rejection. The applicant notes that the field of the technology for Murthy is in ink jet printing devices, a far cry from semiconductor etching technology. Furthermore, Murthy teaches away because it clearly states that wet etching using HFl acid is the process.

Because none of the prior art can be successfully combined with Murthy, all dependent claims are allowable.

Conclusion

The applicant respectfully requests withdrawal of the rejections and believes that the claims as presented represent allowable subject matter. But if the Examiner desires, the applicant is ready for a telephone interview to expedite prosecution. As always, the Examiner is free to call the undersigned at 312-876-2622. The Examiner's attention is also drawn to the new correspondence address.

Respectfully submitted,



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